

REMARKS/ARGUMENTS

In the Office Action mailed January 23, 2009, claims 2-7 and 17-29 were rejected. Additionally, claims 23 and 24 were objected to, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Additionally, claim 30 was allowed. In response, Applicants hereby request reconsideration of the application in view of the proposed amendments and the below-provided remarks. Applicants submit that the proposed amendments place the present application in condition for allowance or in better condition for appeal.

For reference, claims 17 and 27 are amended. In particular, the proposed amendment for claim 17 is presented to recite the top layer defining a laser mounting surface to directly mount the laser in physical contact with the top layer. The proposed amendment for claim 27 is presented to recite similar language. The amendments are supported, for example, by the subject matter described at page 6, paragraph 32, through page 7, paragraph 35, of the specification of the present application.

Allowable Subject Matter

Applicants appreciate the Examiner's review of the claims and determination that claims 23, 24, and 30 recite allowable subject matter. In particular, the Office Action states that claims 23 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Also, the Office Action states that claim 30 is allowable.

Claim Rejections under Non-statutory Double Patenting

Claims 18 and 19 were rejected under the judicially created doctrine of double patenting. Specifically, the Office Action states that claims 18 and 19 of the present application are functionally equivalent to claims 1-61 of Wang (U.S. Pat. No. 6,947,224, hereinafter Wang) in view of Hauer et al. (EP 0942302, hereinafter Hauer), Mueller-Fiedler et al. (U.S. Pat. No. 5,577,142, hereinafter MF), and Johnson (Int'l. Pub. No. WO 01/01497, hereinafter Johnson).

As stated in the MPEP:

“Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is not patentably distinct from the subject matter claimed in a commonly owned patent.”
(Emphasis added)

Applicants submit that the Office Action applies the principle of non-statutory double patenting incorrectly because the Office Action relies on a combination of a commonly owned patent with additional references that are not commonly owned in order to reject claims 18 and 19. However, double patenting only applies to commonly owned applications that claim the same material as the present application or commonly owned applications that are not patentably distinct from the present application. By combining the reference of Wang with references that are not commonly owned (Hauer, MF, and Johnson), the Office Action admits that Wang is, in fact, patentably distinct with respect to the claims of the present application because Wang does not teach all of the limitations of the claims of the present application.

Therefore, the combination of Wang and the additional cited references is improper to support a rejection under non-statutory double patenting. Accordingly, Applicants respectfully request that the rejection under non-statutory double patenting be withdrawn.

Claim Rejections under 35 U.S.C. 112

Claims 2- 7 and 17-29 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, independent claims 17 and 27 were rejected as being indefinite with regard to the laser as being part of the submount or merely stating intended use of the submount. Claims 17 and 27 are amended to recite “the top layer defining a laser mounting surface to directly mount the laser in physical contact with the top layer.”

In regard to the rejection of claims 17 and 27, Applicant submits that claims 17 and 27 are amended to conform to definiteness requirements. Accordingly, Applicant respectfully requests that the rejection of claims 17 and 27 under 35 U.S.C. 112, second paragraph, be withdrawn.

In regard to the rejection of claims 2-7, 18-26, 28, and 29, Applicants submit that the claims 2-7, 18-26, 28, and 29 depend from and incorporate all of the limitations of the corresponding independent claims 17 and 27. Applicant respectfully requests that the rejection of claims 2-7, 18-26, 28, and 29 under 35 U.S.C. 112, second paragraph, be withdrawn based on allowable base claims. Additionally, each of claims 2-7, 18-26, 28, and 29 may be allowable for further reasons.

Claim Rejections under 35 U.S.C. 102 and 103

Claims 3, 7, 17, 20-22, and 27-29 were rejected under 35 U.S.C. 102(b) as being anticipated by, or under 35 U.S.C. 103(a) as obvious over Hauer. Additionally, claims 2-5, 7, 17, 20-22, and 27-29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hauer with MF. Additionally, claims 2-7, 17, 20-22, and 25-29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hauer with MF and Johnson. However, Applicants respectfully submit that these claims are patentable over Hauer, MF, and Johnson for the reasons provided below.

Independent Claim 17

Claim 17 recites “a top layer on the planarization layer, the top layer defining a laser mounting surface to directly mount the laser in physical contact with the top layer” (emphasis added).

In contrast, Hauer does not disclose a laser mounting surface on a top layer on a planarization layer. Hauer merely describes a laser mounted in a depression of the planarization layer. The top layer 2, as relied on in the Office Action, is not directly in contact with the laser 12. Hauer, Fig. 2. The top layer is simply an upper substrate, but does not define a mounting surface for the laser because the laser of Hauer is mounted on the planarization layer. Although Hauer appears to mention a diode mounted on the upper substrate, Hauer does not disclose or teach that the laser is mounted to the upper substrate.

Therefore, Hauer does not disclose or teach a top layer which defines a laser mounting surface to directly mount the laser in physical contact with the top layer because Hauer merely shows mounting the laser on the planarization layer. Accordingly,

Applicants respectfully assert claim 1 is patentable over Hauer because Hauer does not disclose or teach all of the limitations of the claim.

Independent Claim 27

Applicants respectfully assert independent claim 27 is patentable over Hauer at least for similar reasons to those stated above in regard to the rejection of independent claim 17. In particular, claim 27 recites “the top layer defining a laser mounting surface to directly mount the laser in physical contact with the top layer” (emphasis added).

Here, although the language of claim 27 differs from the language of claim 1, and the scope of claim 27 should be interpreted independently of claim 17, Applicants respectfully assert that the remarks provided above in regard to the rejection of claim 17 also apply to the rejection of claim 27. Accordingly, Applicants respectfully assert claim 27 is patentable over Hauer because Hauer does not disclose or teach a top layer defining a laser mounting surface to directly mount the laser in physical contact with the top layer.

Dependent Claims

Claims 2-7, 18-26, 28, and 29 depend from and incorporate all of the limitations of the corresponding independent claims 17 and 27. Applicants respectfully assert claims 2-7, 18-26, 28, and 29 are allowable based on allowable base claims. Additionally, each of claims 2-7, 18-26, 28, and 29 may be allowable for further reasons.

CONCLUSION

Applicants respectfully request reconsideration of the claims in view of the proposed amendments and remarks made herein. A notice of allowance is earnestly solicited.

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account **50-3718** pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees to Deposit Account **50-3718** under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21.

Respectfully submitted,

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